

## **REMARKS**

In response to the Office Action dated September 16, 2009, the Applicants have amended claims 1, 4-5, 7-10 and 19-22. Claims 1-25 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

### **Claim Objections**

The Office Action objected to claims 1, 10, 19 and 22 as failing to provide proper antecedent basis.

In response, the Applicants have amended claims 1, 10, 19 and 22 as suggested by the Examiner to overcome these objections.

### **Rejections Under 35 U.S.C. § 112, first paragraph**

The Office Action rejected claims 1, 10, 19 and 22 under 35 U.S.C. § 112, first paragraph.

The Applicant respectfully traverses this rejection and submits that all of the claims, as currently written, comply with 35 U.S.C. § 112, first paragraph.

On page 4 of the Office Action dated September 16, 2009, the Examiner **incorrectly** stated that the "...applicant's amendment filed on 07/08/2009 contained the limitation 'providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity' is considered new matter since it does not have any support in the specification."

According to *Staehelin v. Seher*, 24 USPQ2d, 1513 (B.P.A.I. 1992), "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than

objective enablement...How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support.” *Id.* At 1516 (citing *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (C.C.P.A 1971)) (emphasis in original).

Examiners can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. *In re Cortright*, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999). The Federal Circuit has clearly stated that patent applications should be written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. *Verve LLC v. Crane Cams Inc.*, 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

The Examiner's statement is unquestionably incorrect and based upon an unsupported blanket conclusion because at least paragraphs [0014], [0016], [0024] and [0034] and FIGS. 1 and 3-7 of the Applicant's published specification (U.S. Patent Publication No. 20050004845) clearly provide support for the claims as written.

For example, first, paragraph [0014] states that each of the “**user profiles** 136 records the **print preferences**” [emphasis added]. Second, paragraph [0016] states that “the **originator** enters and transmits user profile information 153 to the central server 106. In this respect, the user may **manipulate a browser**, for example, to access **user interfaces** or forms served up by the central server 106 and to enter the **profile information** 153 therein that is transmitted to the central server 106” [emphasis added]. Third, paragraph [0024] states that the “print instructions 159 may include an order for the **immediate printing** of the images 156 **rather than a delayed printing** of the images 156 upon reaching a predefined print quantity to ensure economical

shipping quantities” [**emphasis added**]. Next, paragraph [0034] states that if “the print quantity associated with any collection of images 156 for a specific recipient 119 is breached by the total number of images 156 therein, then a printing of the entire collection of images 156 is implemented.”

As undoubtedly described in at least the above paragraphs, the originator is provided with a user interface to allow the originator to either **print images immediately (disassociated with the predetermined economical ship quantities) or delay printing** so that a quantity of images can be accumulated that meets economical specifications (associated with the predetermined economical ship quantities). As such, the images that are **disassociated** with the predetermined economical ship quantities are **immediately printed** and the images that are associated with the predetermined economical ship quantities have delayed printing until a total number of the images breaches the print quantity. Consequently, rejected claims 1, 10, 19 and 22 clearly comply with the 35 U.S.C. § 112, first paragraph.

Further, the Applicant submits that the rejection under 35 U.S.C. § 112 should be withdrawn because the Examiner has not provided a prima facie case to support the rejections under 35 U.S.C. § 112, first paragraph. In particular, contrary to the Examiner’s statement, it is well settled that in order for an Examiner to maintain a prima facie case of not satisfying 35 U.S.C. § 112, first paragraph, the Examiner must provide the following: a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure that purport to teach; the manner and process of making and using the invention that corresponds to the scope of the claims to one of ordinary skill in the art requires undue experimentation; and it deals with subject matter that would not already be known to the skilled person as of the filing date of the application. *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 56 USPQ 1332, 1136 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001).

Merely making incorrect and unsupported conclusions are not enough for the Examiner to maintain a non-enablement rejection. *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999). *In re Wright*, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). The CCPA has stated that the “PTO has the burden of giving

reasons, supported by the record as a whole, why the specification is not enabling” *In re Angstadt*, 190 USPQ 214, 219 (C.C.P.A. 1976). Although the Examiner attempted to bypass this requirement by summarily stating that certain features of the claims are “considered new matter since it does not have any support in the specification,” not only is this interpretation of the law incorrect, it cannot be used as a basis for the Examiner’s rejection under 35 U.S.C. § 112, first paragraph.

As such, the description in the specification provides enabling support for providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity of the independent claims. Hence, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because claims 1, 10, 19 and 22 are enabling and comply with 35 U.S.C. § 112, first paragraph.

#### **Rejections Under 35 U.S.C. § 112, second paragraph**

The Office Action rejected claims 1, 10, 19 and 22 under 35 U.S.C. § 112, second paragraph.

In response, the Applicants have amended claims 1, 10, 19 and 22 as suggested by the Examiner to overcome these rejections.

#### **Rejections Under 35 U.S.C. § 101**

The Office Action rejected claims 1-9 under 35 U.S.C. § 101.

In response, the Applicants have amended claims 1, 4-5 and 7-9 as suggested by the Examiner to include features that tie the process to a computer to overcome these rejections.

### **Rejections Under 35 U.S.C. § 103**

The Office Action rejected claims 1-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reifel (Patent No. 7,013,288) in view of Kurz (Patent No. 6,584,290) and further in view of Barns-Slavin (Patent No. 5,995,950).

The Applicant respectfully traverses this rejection based on the arguments below.

Namely, Reifel simply discloses managing the distribution of image prints (see Abstract of Reifel), Kurz et al. merely disclose a system that informs a user about consumable replacement components (see Summary of Kurz) and Barns-Slavin simply disclose determining discounted shipping charges for groups of parcels having the consignee (see Abstract of Barns-Slavin). As a result, the combination of these cited references do **not** disclose, teach or suggest all of the features of the Applicant's independent claims.

Although the Examiner argued on page 10-11 of the September 16, 2009 Office Action that "Applicant is reminded that claims must be given their broadest interpretation" and then stated that "Reifel teaches a consumer can optionally modify the presented information as needed or desired, the consumer can specify that only certain images are to be reproduced and can specify the type and size of image reproductions on an image-by-image basis", the Applicant submits that the Examiner's interpretation is incorrect.

This is because Reifel is only generally stating that image reproduction can be controlled by a user and **not** maintaining a print quantity associated with predetermined economical ship quantities of the recipient, providing the originator with a user interface to select specific images to be **associated or disassociated** with the predetermined economical ship quantities, **automatically printing the images that are disassociated** with the predetermined economical ship quantities **and** automatically **delaying** printing of images that are associated with the predetermined economical ship quantities **until** a total number of the images included in the collection of images breaches the print quantity of the Applicant's independent claims.

It is clear that the Examiner was attempting to use impermissible hindsight when the Examiner reiterated previous arguments without any actual basis to support the

rejections. It is well-settled law that the Examiner must have a reasonable basis for his conclusions. Namely, the Examiner cannot broadly mischaracterize the references and/or the Applicant's specification and/or claims and then use hindsight to arbitrarily assert that an element in the reference is similar to an element in the claim to support his rejection and then attempt to rely on a boilerplate statement that "claims must be given their broadest interpretation", which is the case here. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992). The Examiner is reminded that according to *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) the Examiner's obviousness rejection is only proper if it **"does not include knowledge gleaned only from the Appellant's disclosure..."** [emphasis added]. The Examiner **clearly included knowledge gleaned only from the Appellant's disclosure** when he rejected claims for obviousness.

Moreover, "[T]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar **"...the opportunity to judge by hindsight is particularly tempting.** Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner ignores a teaching away, which is the case here. *McGinley v. Franklin Sports Inc.*, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Since the Examiner's rejection is unquestionably based on hindsight, the rejection is improper and must be withdrawn. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*

Therefore, since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references, the combined references **cannot** render the claimed invention obvious, and consequently, the Applicants submit that the rejection under 35 U.S.C. §103(a) should be withdrawn. *MPEP 2143*.

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP

§ 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, the Applicants kindly **request** the Examiner to telephone the Applicants' attorney at **(818) 885-1575** with questions. Please note that all mail correspondence should continue to be directed to:

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Respectfully submitted,  
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